

## **REMARKS/ARGUMENTS**

### ***Status of the Application***

Claims 8-12 and 38-42 were rejected. Claims 8-12, 38-39, and 42 were amended as described below. The specification was amended at page 1, after the title, to include a cross-reference to the priority application; at page 3, line 11, to correct typographical errors; at page 3, line 31, to correct typographical errors; at page 20, line 11, for clarity; and at page 21, line 9, for clarity and to correct typographical errors. Thus, claims 8-12 and 38-42 are pending. No new matter was added.

### ***Objections to the Specification***

The specification was objected to for lacking a cross-reference to a related application, contained typographical errors, contained an unclear usage of the term "etc.," and contained a missing reference to temperature standard. Applicants have amended the specification as requested. Other typographical errors were correct as well.

### ***Claim Objections***

Claims 8 and 38 were objected to for depending from withdrawn claim 1. Applicants have amended claims 8 and 38 to incorporate claim 1. Thus, Applicants respectfully submit that these objections have been obviated.

Claims 10 and 12 were objected to for containing the abbreviation "PTH." Applicants have amended the term "PTH" to read "parathyroid hormone." Thus, Applicants respectfully submit that these objections have been obviated.

Claims 39 and 42 were objected to for containing the abbreviation "PAIGB." Applicants have amended the term "PAIGB" to read "parathyroid hormone anabolic induced gene in bone" (see page 13, lines 25-27 for support). Thus, Applicants respectfully submit that these objections have been obviated.

### ***Rejections Under 35 U.S.C. § 101***

Claim 8 was rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants have amended Claim 8 and all dependent

claims to include the word “isolated” before the word “polypeptide.” Thus, Applicants respectfully submit that this rejection has been obviated.

***Rejections Under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph***

Claims 8-12 and 38-42 were rejected under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse these rejections.

Claims 8 and 38 were rejected as being dependent on withdrawn claim 1. As discussed above under “Claim Objections,” Applicants have amended claims 8 and 38 to incorporate claim 1. Thus, any rejection based on dependency from a withdrawn claim should be obviated.

Claim 38 was rejected for being drawn to a non-elected antibody composition. Applicants have amended claim 38 to remove reference to antibody and isolated nucleic acid fragment compositions. Thus, Applicants submit that this rejection has been obviated.

Claim 39 was rejected for lacking antecedent basis for the term “said PAIGB.” Applicants note that there is proper antecedent basis in current claim 38. Specifically section (i) of claim 38 now reads “an isolated nucleic fragment encoding a parathyroid hormone anabolic induced gene in bone polypeptide selected from the group consisting of.” (emphasis added). Thus, Applicants respectfully submit that antecedent basis for the phrase “said parathyroid hormone anabolic induced gene in bone” in current claim 39 has been established.

Because the rejections of claims 8 and 38-39 have been obviated, Applicants respectfully submit that rejections of dependent claims 9-12 and 40-42 under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph, have also been obviated.

***Rejections Under 35 U.S.C. § 102(e)***

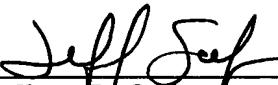
Claims 8-12 and 38-42 were rejected under 35 U.S.C. § 102(e) as being anticipated by Afar *et al.* (WO 03/025138). Claims 8-12 and 38-42 were also rejected under 35 U.S.C. § 102(e) as being anticipated by Tanner *et al.* (U.S. Patent Publication No. 2003/0119043). Applicants respectfully traverse these rejections.

The Examiner asserts that Afar *et al.* and, in the alternative, Tanner *et al.* disclose a polypeptide sequence that has 100% identity to SEQ ID NO:4 of the present application. In response, Applicants submit a Declaration under 37 C.F.R. § 131 swearing behind the 102(e) date of Afar *et al.* and Tanner *et al.* Specifically, Applicants state in the Declaration that the amino acid sequence at issue, SEQ ID NO:4, was reduced to practice in the United States prior to the 102(e) date of either Afar *et al.* or Tanner *et al.* In support of the declaration, Applicants also attach signed notebook pages (Exhibit 1), with dates redacted, that exemplify the human PAIGB protein (see highlighted text). Thus, Applicants respectfully submit that both Afar *et al.* and Tanner *et al.* have been removed as references against the present application.

**Summary**

In view of the foregoing amendments and remarks, Applicants submit that this application is in condition for allowance. In order to expedite disposition of this case, the Examiner is invited to contact Applicants' representative at the telephone number below to resolve any remaining issues. Should there be a fee due which is not accounted for, please charge such fee to Deposit Account No. 501447 (Potter Anderson & Corroon LLP).

Respectfully submitted,

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